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Gabriel Lopez

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September 23, 2004

Date

Docket No. ORT 1474

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: R. Apodaca et al.

Art Unit: 1626

Serial No.: 09/922,619

Examiner: Golam M. Shaleem

Filed: August 6, 2001

Title: NON-IMIDAZOLE ARYLOXY PIPERIDINES

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

REPLY  
AND  
MEMORANDUM OF INTERVIEW

Sir:

This is in reply to an Office Action dated June 24, 2004 requiring restriction among an unspecified number of inventions. The requirement is traversed. A telephonic interview was held with the Examiner on July 15, 2004 to discuss the Action.

The status of the claims is unclear in view of the Office Action which withdraws at least one prior Action and leaves the status of the response thereto ambiguous.

The Examiner has required restriction among a list of inventions which are said to be "not exhausted" because "it would be impossible to group all the invention (*sic*) under the time constraints". No citation has been provided by the Examiner to a statutory reason to not list all the inventions because of time constraints. It is requested that the Examiner provide the statutory basis for the failure to provide applicants with a list of all the inventions among which applicants are expected to select.

The Examiner has indicated that the present Office Action supercedes the previous Office Action, dated July 7, 2003. The Examiner has made no statement regarding all the other Office Actions (beginning on May 22, 2002) that are part of the record of this application nor has he made a statement regarding all the responses which applicants have made to said Actions. It is requested that the Examiner provide a specific list of which Actions and which responses are still part of this record. Applicants' attorney submits that all previous papers are part of the record and the search and actions undertaken by the previous examiner may not be

**withdrawn**. Under MPEP 704.01, second paragraph, the present examiner must give “**full faith and credit**” to the previous search and actions, unless the Examiner can show that the previous Examiner made a clear error in her actions.

#### **PREVIOUS EXAMINER'S SEARCH**

When an examiner is assigned to act on an application which has received one or more actions by some other examiner, full faith and credit should be given to the search and action of the previous examiner unless there is a clear error in the previous action or knowledge of other prior art. In general the second examiner should not take an entirely new approach to the application or attempt to reorient the point of view of the previous examiner, or make a new search in the mere hope of finding something. (See MPEP 719.05.)

Consequently, applicants' attorney respectfully does not agree that the prior Office Action (or Actions?) has been superceded.

During the telephonic interview, applicants' attorney requested that the Examiner withdraw the Restriction Requirement and continue prosecution of the application with the reply of April 2, 2004. The Examiner responded that he cannot withdraw the Action. However, that is exactly what the Examiner has done - he has withdrawn a previous Office Action. It is unclear why the Examiner can withdraw another Examiner's Actions (which span a 2-year period), but cannot withdraw his own. The Examiner's only explanation was that he was directed by his SPE to issue the Restriction Requirement. This is not deemed to be a statutory basis for the Action.

The Examiner has suggested that the present invention cannot be searched because of the plurality of inventions claimed: "A separate search considerations (sic) are involved, which would impose a burden if unrestrained". However, the present invention **has already been searched and examined**. Since the previous Examiner's search and actions are part of the record and must be given “**full faith and credit**,” applicants' attorney fail to understand the basis of the Restriction Requirement presented in the Office Action of June 24, 2004. Applicants' attorney directs the Examiner's attention again to MPEP 704.01, second paragraph, that specifically discourages second examiners from undertaking new searches. The MPEP does not make an exception for directions given by an Examiner's SPE. To facilitate applicants' understanding of why an additional search is required at this time, applicants' attorney requests that the Examiner provide the original field of the search that was previously searched and explain the clear error that now requires a new search be undertaken and what areas the Examiner proposes to search that were not previously searched. Accordingly, applicant's attorney submits that the Restriction Requirement and Election in the Office Action of June 24, 2004 is improper and must be withdrawn.

A restriction requirement can be made at any time in the prosecution of a patent application (MPEP 811). However, to make such a restriction requirement MPEP 803 must be complied with. MPEP 803 states two requirements for a proper restriction requirement:

### **803 Restriction - When Proper**

Under the statute an application may properly be required to be restricted to one of two or more claimed inventions only if they are able to support separate patents and they are either independent (MPEP 806.04-806.04(i)) or distinct (MPEP 806.05-806.05(i)).

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

### **CRITERIA FOR RESTRICTION BETWEEN PATENTABLY DISTINCT INVENTIONS**

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

(A) The inventions must be independent (see MPEP 802.01, 806.04, 808.01) or distinct as claimed (see MPEP 806.05 - 806.05(i)); and

(B) There must be a serious burden on the examiner if restriction is required (see MPEP 803.02, 806.04(a) - 806.04(i), 808.01(a), and 808.02).

If a restriction requirement is made after the first Office Action, the examiner is specifically directed to consider whether there will be a serious burden on the examiner (MPEP 811). Since the previous examiner's actions must be given "**full faith and credit**" and the invention has already been searched and examined, applicants' attorney fails to understand the serious burden that the Examiner is complaining of. Applicants' attorney submits that the Examiner has not met the second requirement of MPEP 803. Accordingly, applicant's attorney submits that the Restriction Requirement and Election in the present Office Action is improper and must be withdrawn.

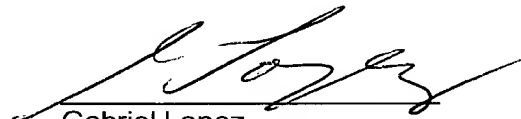
With regard to the Election Requirement and Restriction Requirement, applicants' attorney submits that the Election Requirement and Restriction Requirement are improper. The rationale for the Restriction Requirement in the present Office Action is that Groups I-IV "differ materially in structure and in element". However, applicants' attorney submits that the subject matter of Group I-IV claimed similar chemical structures when originally filed, searched, and examined, as evidenced by the fact that there has been no prior Restriction Requirement in the prosecution of the application.. The prior amendments to the claims have not made the claims materially different and do not necessitate a new search. Accordingly, **the chemical structures of these claims have already been search and examined**. Applicants' attorney,

therefore, fails to understand the Examiner's argument that the claims are materially different in chemical structure. Additionally, applicants' attorney fails to understand why the original claims could be and were searched before and now the amended claims need to be but can no longer be searched. Applicant's attorney fails to appreciate why a new search is necessary. This is especially difficult to understand because the claims submitted on April 2, 2004 are narrower in scope than the original searched and examined claims. For these reasons applicants' attorney respectfully that the Restriction Requirement as well as the Election of Species Requirement is improper and must be withdrawn.

It is requested that the Restriction Requirement be withdrawn and that prosecution of the application continue with applicants' last reply. If this is not done, then it is requested that the Examiner provide applicants with answers to the requests made herein for support for the Examiner's action.. However, and solely to preserve applicants' rights, applicants provisionally elect Group I, with traverse, and the compound 1-[4-(1-Isopropyl-piperidin-4-yloxy)-benzyl]-4-methyl-piperazine.

It is requested that the period for response be extended two months to September 24, 2004. The Commissioner is hereby authorized to charge the extension fee of **\$420** and any other fees which may be required by this paper to Deposit Account 10-0750/ORT 1474/GL.

Respectfully submitted,



Gabriel Lopez  
Attorney for Applicants  
Reg. No. 28,440  
(732) 524-3606

Johnson & Johnson  
One Johnson & Johnson Plaza  
New Brunswick, NJ 08933-7003

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